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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/882,197 06/25/97 GREER

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EXAMINER

LM01/1207

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CAUDLE, P

ART UNIT

PAPER NUMBER

2765

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12/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

**Office Action Summary**

Application No.

08/882,197

Applicant(s)

GREER ET AL.

Examiner

Penny Caudle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☐ Responsive to communication(s) filed on 15 October 1999.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. In response to the Amendment filed on October 15, 1999 claims 1-10, 12-16 and 19-20 have been amended, and new claims 21-38 have been added. Claims 1-38 are pending.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 7, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "significance" in claims is a relative term which renders the claim indefinite. The term "significance" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of the examination significance is interpreted to include any data which is useful to the content provider therefore any data collected the content provider would be deemed as significant as to gather and store insignificant data would be useless.

4. Claims 22-26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As per claim 22, it is unclear how the user profile identifies and connects to the target computer via a rule page identification number.

As per claims 23-26 they are rejected as being dependent from a rejected base claim.

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5. Claims 31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 recites the limitation "providing the new rule" in line 1. There is insufficient antecedent basis for this limitation in the claim. In addition, it is unclear how the cited steps of obtaining a user profile, identifying the target computer via a rule page identification based on the user profile and connecting to the target computer would allow providing a rule or a rule page.

As per claims 32-35 they are rejected as being dependent from a rejected base claim.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (U.S. 5,796,952) in view of Fitzpatrick et al (U.S. 5,423,043).

As per claim 1, Davis et al discloses a system comprising the following:

-content provider to transmit a content to a target computer using a rule book based on user information, as stated in the abstract, "The monitored information and client identifying indicia is stored on a database in a server for use in analysis and for automatically serving out files assembled according to user interests and preferences.";

-a collecting agent to provide the user information to the content provider according to the significance of the user information, as stated in column 4 lines 37-63, "...a tracking program

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is embedded in a file which is downloaded from a server to a client...and runs on the client to monitor various indicia...in order to track the user's interaction with and use...After monitoring the user's interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis..." and column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.";

-a program running on the content provider, the program organizes the user information and updates a user specific database, as stated in column 4 lines 64-67, "The acquired information is preferably stored on a server and used to build historical profiles of individual users, to serve out highly targeted information based upon user profiles..."

Davis et al fails to disclose a triggering agent to determine the significance of the user information. Fitzpatrick et al disclose a system wherein an agent is provided to monitor, build, maintain, and recall links based on prior actions and user choices(col. 2 lines 27-32). In addition, the agent may act continuously to record actions and build links passively or on demand based on user specific user signals such as a trigger. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the advertising system taught by Davis with the addition of a triggering agent as disclosed by Fitzpatrick et al in order to prevent storage of duplicate information in the user profile.

Davis et al and Fitzpatrick fail to explicitly disclose using a "rulebook" for transmitting content to a target computer. Davis et al does disclose that user profiles which are stored in a database

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are used to determine which content to download to the user using logical expression i.e. condition-action pairs or if-then statements. Official Notice is given that the creation and use of “rules” for abstraction or data manipulation within databases is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant invention to instantiate the a logical expression taught by Davis et al within a “rulebook” in order to provide generic rules for disseminating the content to be downloading thereby allowing the rules to be applied to the specific user profiles as data is gathered.

As per claims 2-6, Davis et al and Fitzpatrick et al disclose all the limitations as discussed in paragraph 7 of paper number 10

As per claim 7, Davis et al disclose a method of communicating information comprising the following:

- transmitting a content from a content provider to a target computer using a rule book based on user information, as stated in the abstract, “The monitored information and client identifying indicia is stored on a database in a server for use in analysis and for automatically serving out files assembled according to user interests and preferences.”;

- providing the user information, by a collecting agent, to the content provider according to the significance of the user, as stated in column 4 lines 37-63, “...a tracking program is embedded in a file which is downloaded from a server to a client...and runs on the client to monitor various indicia...in order to track the user’s interaction with and use...After monitoring the user’s interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis...” and column 9

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lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.";

-transmitting the user information from the target computer to the content provider, as stated in column 4 lines 56-59, "After monitoring the user's interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis..."

Davis et al fails to disclose a triggering agent to determine the significance of the user information. Fitzpatrick et al disclose a system wherein an agent is provided to monitor, build, maintain, and recall links based on prior actions and user choices(col. 2 lines 27-32). In addition, the agent may act continuously to record actions and build links passively or on demand based on user specific user signals such as a trigger. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the advertising system taught by Davis with the addition of a triggering agent as disclosed by Fitzpatrick et al in order to prevent storage of duplicate information in the user profile.

Davis et al and Fitzpatrick fail to explicitly disclose using a "rulebook" for transmitting content to a target computer. Davis et al does disclose that user profiles which are stored in a database are used to determine which content to download to the user using logical expression i.e. condition-action pairs or if-then statements. Official Notice is given that the creation and use of "rules" for abstraction or data manipulation within databases is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the

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applicant invention to instantiate the a logical expression taught by Davis et al within a “rulebook” in order to provide generic rules for disseminating the content to be downloading thereby allowing the rules to be applied to the specific user profiles as data is gathered.

As per claim 8, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose transmitting an agent from the content provider to the target computer. As stated in column 4 lines 37-40, “...a tracking program is embedded in a file which is downloaded from a server to a client.”.

As per claim 9, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose the collecting agent is an agent running on the target computer. As stated in column 4 lines 45-46, “The tracking program is downloaded from a server and runs on the client...”.

As per claim 10, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 8 above. In addition Davis et al disclose the agent being transmitted with the content. As stated in column 14 lines 22-30, “...the tracking program is downloaded...with the HTML document in response to a TCP/IP client request...displaying both the Web page and the ad banner embedded in the Web page...”.

As per claim 11, Davis et al and Fitzpatrick et al all the limitations as set forth in claim 9 above. In addition Davis et al disclose the agent is independent of a browser executing on the target computer. As stated in column 17 lines 45-46, “In addition the tracking program need not be a program that executes on the client computer.”.



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As per claim 12 , Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose the content is transmitted in an Internet protocol format. As stated in column 14 lines 22-30, "...the tracking program is downloaded...with the HTML document in response to a TCP/IP client request...displaying both the Web page and the ad banner embedded in the Web page...".

As per claim 13, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose receiving user information from the target computer, filtering the user information to create significant data, arranging the significant data to create a modified user database and generating a second user content. As stated in the abstract, "The monitored information and client identifying indicia is stored on a database in a server for use in analysis and for automatically serving out files assembled according to user interests and preferences." , and in column 14 lines 62-65, "...user profile database may be used to determine which of the resources is to be downloaded to that client using simple logical processing instructions.".

8. Claims 14, 16-21, 27-30, and 36-38 rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (U.S. 5,796,952).

As per claim 14, Davis et al disclose a content provider for providing content over a network comprising:

-a user profile corresponding to a target computer account, as stated in the abstract, "The monitored information and client identifying indicia is stored on a database in a server for use in

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analysis and for automatically serving out files assembled according to user interests and preferences.”; and

-a rulebook to select data to be transmitted to the target computer according to the user profile, the rule book providing a rule having a condition-action pair, as stated in the abstract, “The monitored information and client identifying indicia is stored on a database in a server for use in analysis and for automatically serving out files assembled according to user interests and preferences.”, and in column 14 lines 62-65, “...user profile database may be used to determine which of the resources is to be downloaded to that client using simple logical processing instructions.”.

Davis et al fail to explicitly disclose using a “rulebook” for transmitting content to a target computer. Davis et al does disclose that user profiles which are stored in a database are used to determine which content to download to the user using logical expression i.e. condition-action pairs or if-then statements. Official Notice is given that the creation and use of “rules” for abstraction or data manipulation within databases is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant invention to instantiate the a logical expression taught by Davis et al within a “rulebook” in order to provide generic rules for disseminating the content to be downloading thereby allowing the rules to be applied to the specific user profiles as data is gathered.

As per claim 16, Davis et al disclose all the limitations as set forth in claim 14 above. In addition Davis et al discloses a condition-action pair includes a hardware characteristic of a target computer associated with the target computer account. As stated in column 9 lines 41-45,

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"...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer."

As per claim 17, Davis et al disclose all the limitations as set forth in claim 16 above. Davis et al fail to disclose that the hardware characteristic is a modem speed. Official Notice is given that the use of modem speed in hardware profiles for directing user specific advertising to users is old and well known in the art, as evidenced by the Newswire article "C/NET: The Computer Network Unveils Revolutionary Internet Advertising Tools that Allow Custom Banner Ad Delivery Based on Demographic Information". Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Davis et al and Fitzpatrick et al with the addition of modem speed as a hardware characteristic in order to the user with the most relevant advertising for their particular interest and hardware.

As per claim 18, Davis et al disclose all the limitations as set forth in claim 16 above. In addition Davis et al disclose when the hardware characteristic satisfies a first condition, high fidelity ad content is transmitted, and when the hardware characteristic satisfies a second condition, lower fidelity ad content is transmitted. As stated in column 15 lines 33-36, "...and the previously constructed historical database profile (S607B), different information (images, sounds, text, etc.) May be returned to the applet."

As per claim 19, Davis et al disclose all the limitations as set forth in claim 14 above. In addition Davis et al discloses the user profile includes at least one rule page including a plurality of keys, the plurality of keys includes a hardware profile to indicate hardware capabilities of the

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target computer associated with the target computer account. As stated in column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer."

As per claim 20, Davis et al disclose all the limitations as set forth in claim 19 above. Davis et al fail to disclose that the plurality of keys includes a software profile to indicate software used by the target computer account. Official Notice is given that the inclusion of software used in user profiles is old and well known in the art, as evidenced by the Newswire article "C/NET: The Computer Network Unveils Revolutionary Internet Advertising Tools that Allow Custom Banner Ad Delivery Based on Demographic Information". Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Davis et al and Fitzpatrick et al with the addition of software profiles in order to the user with the most relevant advertising for their particular interest and hardware.

As per claims 21 and 30, Davis et al disclose all the limitations as set forth in claims 1 and 7 above. Davis et al fail to disclose the rule book provides a rule page corresponding to the target computer. However, as discussed in claim 1 above it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply the general rules of the "rulebook" to the specific users via the use of the data within their respective profiles in order to provide rules for a particular user or target computer rather thereby reduced in the number of rules to be processed during the downloading of the user specific content.

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As per claims 27 and 36, Davis et al disclose all the limitations as set forth in claims 21 and 32 above. In addition Davis et al disclose the rule as a form of condition-action pair. As stated in column 14 lines 62-65, "...user profile database may be used to determine which of the resources is to be downloaded to that client using simple logical processing instructions."

As per claims 28 and 37, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claims 27 and 36 above. In addition, Davis et al discloses the rule matches the content with characteristics of the target computer. As stated in the abstract, "The monitored information and client identifying indicia is stored on a database in a server for use in analysis and for automatically serving out files assembled according to user interests and preferences."

As per claims 29 and 38, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 1 and 7 above. In addition Davis et al disclose the content is an advertisement banner. As stated in column 5 lines 12-13, "...be a file such as a Web page or part of a Web page (such as an ad banner)."

### *Response to Arguments*

9. Applicant's arguments with respect to claim 1-20 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments with regard to the "triggering agent" have been fully considered but they are not persuasive. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the advertising system taught by Davis with the addition of a triggering agent as disclosed by Fitzpatrick et al in order to identify triggers which

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are relevant to the content provider such as interaction with a downloaded advertisement in order to collect data significant to the analysis or the advertising content..

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

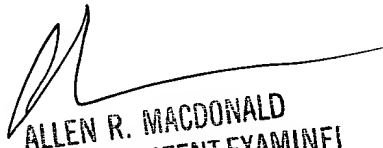
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Penny Caudle whose telephone number is (703) 305-0756. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

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The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
ALLEN R. MACDONALD  
SUPERVISORY PATENT EXAMINER  
DEC 3 1999

plc

December 3, 1999